

Appl. No. 10/084,587
Response dated July 5, 2005
Reply to Office Action of on May 25, 2005

PATENT

REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed on May 25, 2005.

Prior to this Amendment, claims 1-40 were pending and subject to examination.

In this Amendment, no claims are amended and no claims are added. Accordingly, claims 1-40 are pending and subject to examination.

In the Office Action, claims 1-40 are provisionally rejected under the doctrine of obviousness type double patenting.

Applicants note this rejection, and request that this rejection be held in abeyance until the claims are otherwise allowable.

Claims 1-15, 17-19, 21-35, and 37-40 are rejected as anticipated under 35 U.S.C. 102(e) by Paulse et al. (U.S. Patent Publication No. 2004/00599530). The cover of Paulse et al. indicates that it has an effective reference date of November 16, 2000, based on the filing date of abandoned U.S. Provisional Application No. 60/249,835. This rejection is traversed.

The Examiner again alleges that Paulse et al. is prior art under 35 USC § 102(e). However, it is not. 35 USC § 102(e) states:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.
(emphasis added.)

Paulse et al. is not prior art under 35 USC § 102(e), since Provisional Application No. 60/249,835 is in the current chain of priority (see page 2 of Applicants' Amendment filed on November 13, 2004). The earliest effective filing date for the present application is November 16, 2000, which is the same as the earliest effective reference date for Paulse et al.

In response to the above argument, the Examiner states that MPEP 201.11 states that a claim to the benefit under 35 U.S.C. 119(e) and 120 ... must be made during the pendency of the application and within 4 months from the actual date of the application or 16 months from

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the date of the prior application. ... Since none of the above [was met], therefore the priority date claimed (11-16-2000) is not valid, and the rejection stands."

Applicants disagree. Attached hereto are copies of the Official Filing Receipt for the present application as well as a copy of the cover page of U.S. Patent Application Publication No. US 2002/0193950, which corresponds to the present application. Both of these documents acknowledge that the present application claims the benefit of the filing date of U.S. Provisional Patent Application No. 60/249,835, filed on November 16, 2000. In addition, the original application filing papers for this application indicated that the filing date of November 16, 2000 was claimed. Accordingly, contrary to the Examiner's assertions, the PTO has officially indicated that the present application is entitled to the November 16, 2000 filing date.

Contrary to the Examiner's assertions, a petition to accept a delayed priority claim is not required in this case, since the PTO has officially acknowledged the November 16, 2000 filing date. MPEP § 201.11, page 200-64, Rev. 2, May 2004, states:

If an applicant includes a claim to the benefit of a prior application elsewhere in the application, but not in the manner specified in [37 C.F.R. 1.78] (e.g., if the benefit claim is included in an unexecuted oath or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a)(2)(ii) or (a)(5)(ii), the Office will not require a petition and the surcharge under 37 CFR 1.17(t) to correct the benefit claim if the information concerning the benefit claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt. This is because the application will have been scheduled for publication on the basis of such information concerning the benefit claim.

As noted above, as shown by the attached Filing Receipt, the PTO recognizes that the present application claims priority to U.S. Provisional Application No. 60/254,746, filed on November 16, 2000. U.S. Patent Application Publication No. 2002/0193950 was also scheduled for publication based on the filing date of November 16, 2000. Accordingly, a petition to accept a delayed priority claim is not required in this case and the effective filing date for the present application is November 16, 2000.

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Applicants again respectfully request withdrawal of the rejection based on Paulse et al. because it is not prior art.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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